

Applicant maintains the position that the Examiner is imposing an extra-statutory requirement by requiring the application to include disclosure of specific phrases recited in the claims. Specifically, in response to Applicant's arguments, the Examiner alleges that "the specification is completely void of *any phrasing* or *similar language*," emphasis added (*see* page 2 of the Office Action). Applicant respectfully submits that this is not the standard under MPEP § 2163.

The test for resolving issues of enablement is well-established: whether *one reasonably skilled in the art* could make and use the invention from the disclosure in the patent coupled with information known in the art without undue experimentation. See, e.g., Northern Telecom v. Datapoint 15 USPQ2d 1321, 1328-30 (Fed. Cir. 1990); U.S. v. Telectronics 8 USPQ2d 1217, 1222-24 (Fed. Cir. 1988). A patent document is not intended to be a production specification. Id. It is respectfully submitted that one of ordinary skill in the art, given Applicant's specification, and knowledge generally available, could readily understand that "the send order" is placed when the switch is not the destination and that "the send order" does not depend on destination, as explained in greater detail below. Indeed, the Examiner has not provided any reason or evidentiary support for concluding the contrary.

MPEP § 2163.02 specifically states that "the subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement." The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art *would not recognize* in an applicant's disclosure a description of the invention defined by the claims. MPEP § 2163.04. In fact, there

is no need for the specification to explicitly describe the unique features of the invention being claimed. Each claim limitation need only be explicitly, implicitly, or inherently supported in the originally filed disclosure, MPEP § 2163.05.

One of ordinary skill in the art would readily appreciate and recognize the unique features of the invention claimed in claims 12 and 13 from the original specification. For instance, in the exemplary, non-limiting embodiment, Fig. 2 shows that when the destination of the signaling message is not here *i.e.*, not the switch, step 26, a flag with a predetermined order corresponding to “send order” is added, step 27 (*see* page 7, line 27 to page 8, line 12 of the specification).

The predetermined “send order” is to be added to the message whatever the protocol that is to be used thereafter in conveying it to the exchange 19 (*see* page 6 of the specification).

Specifically, page 6, lines 9 to 12 recites

[i]n the interpreter 14, the message
“SIGNALLING” produced by the member 15
receives a predetermined additional
character string in operation 22, which
string is ***always the same***, emphasis added.
[t]his character string represents a send
order.

That is, if in the exemplary, non-limiting embodiment, a predetermined order *i.e.*, “sent order” is added when the destination is not the switch, then one of ordinary skill in the art would readily appreciate that the same predetermined order is added to send the message, as is also explicitly states in the exemplary embodiment of the present invention. Where the signaling message is to be sent is irrelevant for adding the send order, as it is always the same.

It will be appreciated that the foregoing remarks relate to the invention in a general sense. These remarks are not necessarily limitative of any claims including claims 12 and 13 and are

RESPONSE UNDER 37 C.F.R. § 1.116
U.S. Appln. No. 09/323,135
Attorney Docket No.: Q54622

intended only to help the Examiner better understand the allegedly non-enabling aspects of the claims discussed above. For at least the above-discussed exemplary reasons, Applicant respectfully requests the Examiner to withdraw this rejection of claims 12 and 13.

§ 102(e) Rejection

Claims 1, 3, 5, 7 and 8 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,995,595 to Hickey et al. (hereinafter “Hickey”). Applicant respectfully traverses in view of the following remarks.

Of these claims, only claims 1 and 3 are independent. Independent claim 1 recites a number of unique features not taught by the prior art references cited by the Examiner. For example, claim 1 recites:

an interpreter producing a signaling configuration upon receiving an order to send a signaling message, the signaling configuration produced depends on a type of the signaling channels accessible to the coupler...

Applicant respectfully submits that the unique combination of claim 1 including at least the claimed signaling configuration produced depends on a type of the signaling channels accessible to the coupler is absent from the teachings of Hickey. The Examiner alleges that Hickey’s “D-channels” are equivalent to producing signaling configuration depending on a type of the signaling channels accessible to the coupler, as set forth in claim 1 (see pages 3-4 of the Office Action). Applicant respectfully disagrees with the Examiner.

First, Applicant respectfully submits that Hickey discloses one single signaling channel D (col. 1, lines 22 to 26 and col. 3, lines 9 to 11). That is, in Hickey, there is no “plurality of

RESPONSE UNDER 37 C.F.R. § 1.116
U.S. Appln. No. 09/323,135
Attorney Docket No.: Q54622

signaling channels D.” If the Examiner disagrees, Applicant respectfully invites the Examiner to provide supporting sections of the Hickey reference.

Furthermore, Hickey fails to teach or suggest *any correlation* between the D channel and the setup message. In fact, Hickey does not address the signaling channels or how the set up message is construed. It is simply not the focus of Hickey’s teachings.

The Examiner alleges that having “an incoming call be presented as a D channel message to the network interface which passes the D channel message through the D signaling channel” somehow discloses producing the signaling configuration that depends on a type of signaling channels (*see* page 3 of the Office Action). Clearly, no dependency is present in this phrase. All that the passage relied on by the Examiner discloses is that the D channel message is received and sent through the D channel.

Moreover, as is clearly visible from Hickey, the D channel is used for conveying signaling packets to effect signaling message between the ISDN telephones and the network (col. 3, lines 8 to 20). Clearly, Hickey’s teachings of sending the message over the D channel cannot be equated with producing signaling configuration based on type of signaling channels. In addition, in Hickey, there is no teaching or even remote suggestion that the type of signaling channel somehow impacts the signaling configuration. Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. Applicant respectfully submits that Hickey’s disclosure of having a D message transmitted on a D channel lacks to identically disclose or suggest producing the signaling configuration depending on the type of signaling message. In fact, the passage relied on by the Examiner, does

RESPONSE UNDER 37 C.F.R. § 1.116
U.S. Appln. No. 09/323,135
Attorney Docket No.: Q54622

not teach or suggest producing the D channel messages, let alone any dependency on the type of signaling channels available.

Therefore, “an interpreter producing a signaling configuration upon receiving an order to send a signaling message, the signaling configuration produced depends on a type of the signaling channels accessible to the coupler...,” as set forth in claim 1 is not suggested or taught by Hickey, which clearly lacks having more than one type of signaling channels available to the network interface, and producing the signaling configuration based on the type of the signaling channels. For at least these exemplary reasons, Applicant respectfully submits that claim 1 is patentably distinguishable and is patentable over Hickey. Therefore, Applicant respectfully requests the Examiner to withdraw this rejection of claim 1.

Next, independent claim 3 recites features similar to the features argued above with respect to claim 1. Since claim 3 contains features that are similar to the features argued above with respect to claim 1, those arguments are respectfully submitted to apply with equal force here. For at least substantially analogous reasons, therefore, Applicant respectfully requests the Examiner to withdraw this rejection of independent claim 3 and its dependent claim 5.

Furthermore, since claims 7 and 8 dependent upon claim 1, they are patentable at least by virtue of their dependency.

§ 103(a) Rejection

Claims 2, 4, 6, and 11-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hickey in view of U.S. Patent No. 5,949,871 to Kabay et al. (hereinafter “Kabay”). Applicant respectfully traverses this rejection in view of the following comments.

RESPONSE UNDER 37 C.F.R. § 1.116
U.S. Appln. No. 09/323,135
Attorney Docket No.: Q54622

Claims 2 and 9-13 depend on claim 1 and claims 4 and 6 depend on claim 3. Applicant has already demonstrated that Hickey fails to teach or suggest the unique features of the independent claims 1 and 3. Kabay does not cure the deficient teachings of Hickey. Therefore, dependent claims 2, 4, 6, and 9-13 are patentable over the combined teachings of Hickey and Kabay at least by virtue of their dependency on claim 1 or 3.

In addition, dependent claim 2 recites: *a detector recognizing whether the receiver signaling message is addressed to the switch*. The Examiner now alleges that Kabay's method of ascertaining whether service implementation action is required with respect to the call associated with the control message is capable of recognizing whether the received signaling message is addressed to the interceptor box (*see* page 5 of the Office Action). Applicant respectfully disagrees. Kabay teaches intercepting the message, and processing the trigger data when the call comes from a ported caller or to a ported called party. To recognize the interceptor box, an address or some form of identification is needed. Applicant respectfully invites the Examiner to recite the passages in Kabay that would provide an identification of the interceptor box. Indeed, the interceptor box is not configured to perform that functionality, and without some sort of identification such detection is impossible.

Moreover, the detector as set forth in claim 2 is part of the switch, whereas the interceptor box is a separate entity and not a part of another entity (Fig. 10; col. 7, lines 43 to col. 8, line 10).

For at least these additional reasons, Applicant respectfully submits that claim 2 is patentable over the combined teaching of Hickey and Kabay.

RESPONSE UNDER 37 C.F.R. § 1.116
U.S. Appln. No. 09/323,135
Attorney Docket No.: Q54622

Allowable Subject Matter

Applicant thanks the Examiner for indicating that claims 9 and 10 contain allowable subject matter. Applicant respectfully holds the rewriting of these claims in abeyance until arguments presented with respect to claim 1 have been reconsidered.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860


WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: September 23, 2005

Respectfully submitted,


Nataliya Dvorson
Registration No. 56,616

Attorney Docket No.: Q54622